Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEETHARAMAIAH MANNAVA, JAMES E. RHODA, HERBERT HALILA, LARRY G. JACOBS, and EDWARD A. RAINOUS

Appeal No. 2000-2166
Application No. 08/719,341

ON REMAND

Before COHEN, ABRAMS, and FRANKFORT, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

REMAND

The present application is being remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for appropriate action with regard to the issue discussed below.

In reviewing the rejection dated February 22, 1999 (Paper No. 32) and the examiner's answer (Paper No. 36), we find that

the examiner has rejected claims 1 through 20 under the judicially created doctrine of double patenting over claim 1 of U.S. Patent No. 5,531,570 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. It is particularly noteworthy that the examiner relies upon *In re Schneller*, 397 F.2d 350, 355, 158 USPQ 210, 215 (CCPA 1968) in the body of the rejection, as set forth on page 8 of the referenced rejection.

The *Manual of Patent Examining Procedure* (MPEP) § 804 (Eighth Edition, August 2001) states the following at 800-27:

> The decision in *In re Schneller* did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. The court in *Schneller* cautioned "against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations." *Schneller*, 397 F.2d at 355, 158 USPQ at 215. Nonstatutory double patenting rejections based on *Schneller* **will be rare**. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.

This panel of the Board remands this application to the examiner to permit reconsideration of this rejection consistent

with the guidance provided in the foregoing quotation from MPEP § 804, regarding the propriety of the rejection based upon *Schneller*, and to obtain the approval of the TC Director if the examiner and the SPE desire to maintain this rejection.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, August 2001).

If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, e.g., the 35 U.S.C. § 103(a) rejections, the application should be promptly returned to the Board of Patent Appeals and Interferences.

REMANDED

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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NEAL E. ABRAMS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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CHARLES E. FRANKFORT)
Administrative Patent Judge)

ICC:psb

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